

Appl. No.: 09/903,242
Response dated October 31, 2005
Reply to Office action of August 22, 2005

REMARKS/ARGUMENTS

I. Status of the Claims and Drawings

Applicants received the Office Action dated August 22, 2005 in which the Examiner rejected claims 1 – 4 under 35 U.S.C. § 103(a) as being unpatentable over Hori et al. (U.S. Patent No. 5,594,455). The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Hori in view of Plasson et al. (U.S. Patent No. 6,795,688). The Examiner rejected claims 6 – 14 under 35 U.S.C. § 103(a) as being unpatentable over Tran et al. (U.S. Application Pub. No. 2002/0194621 A1) in view of Hori. The Examiner also objected to the drawings. Based on the arguments contained herein, Applicants believe this case to be in condition for allowance.

II. Objection to Drawings Unclear

Item No. 10 of the Office Action Summary indicates that the drawings filed on July 11, 2001 are objected to by the Examiner. However, the Examiner does not provide a reason as to why the Examiner objects to the drawings. Clarification is requested.

III. *Prima Facie* Case of Obviousness Not Established for Claims 1 – 5

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

MPEP 706.02(j). Claim 1 requires an FR-4 circuit board having a thickness of $0.06 \pm 10\%$ inches, a ground plane having a width of at least $1.875 \pm 10\%$ inches and a length of at least $2.25 \pm 10\%$ inches, a rectangular patch having a width of $1.5 \pm 10\%$ inches and a length of $1.162 \pm 10\%$ inches, and a feed having a width of $0.07 \pm 10\%$ inches and a length of at least $0.625 \pm 10\%$ inches. Although the Examiner concedes that Hori does not explicitly disclose these numerical parameters, the Examiner asserts that "it would have been an obvious matter of design choice to have different size of ground plane, the

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patch and the feed, since such a modification would have involved a mere change in the size of a component."

However, as a matter of law, Applicants respectfully point out that the Examiner cannot simply characterize a claim limitation as a "design choice" without providing sufficient evidence for such a characterization:

The examiner's unsupported, conclusionary statement regarding obvious design choice is not a substitute for evidence. As the examiner has not pointed to any teaching or suggestion in the prior art that would have suggested [the claimed invention], we find that the examiner has failed to establish a *prima facie* case of obviousness...

Ex parte Yamakawa, Appeal No. 2002-2082 (B.P.A.I. 2003). Instead, such a rejection must point to prior art references that "provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984); *see also In re Chu*, 66 F.3d 292, 299 (Fed. Cir. 1995) (obviousness rejection based on "design choice" inappropriate when there is no teaching or suggestion in the cited prior art to modify that characteristic as in the claimed invention). Without the benefit of the instant application, there is no motivation to modify Hori to produce the invention of claim 1. Thus, the Examiner fails to establish a *prima facie* case of obviousness. Claim 1 and dependent claims 2 – 5 are patentable at least for this reason.

Moreover, the Examiner fails to establish a *prima facie* case of obviousness because Hori does not teach or suggest all of the limitations of claim 1. In particular, as mentioned above, Hori does not teach the numerical parameters recited by claim 1. The significance of the numerical parameters recited by claim 1 should not be disregarded, since these specific parameters may help characterize the invention of claim 1. For example, that the FR-4 circuit board has a thickness of "0.06 ± 10% inches" may enable the patch antenna of claim 1 to operate in a certain frequency band. In addition to the fact that Hori does not teach the numerical parameters of claim 1, Hori does not teach "an FR-4 circuit board" as required by claim 1, but instead teaches a Teflon® substrate (column 6, line 23). This difference is significant due to a variety of reasons, such as the difference in dielectric constants between FR-4 material and Teflon® material. Because Hori does not teach or even suggest these limitations of claim 1, the Examiner fails to establish a *prima*

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facie case of obviousness. At least for this reason, as well as the reasons presented above, claim 1 and dependent claims 2 – 5 are in condition for allowance.

IV. Tran Does Not Preclude Patentability Of Claims 6 – 14

Claims 6 – 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tran in view of Hori.

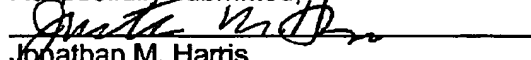
Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c). Applicants do not agree with the Examiner that Tran constitutes prior art to the instant application. However, inasmuch as Tran may be prior art to the instant application, Tran would qualify as prior art only under 35 U.S.C. § 102(e). At the time the invention of the instant application was made, both Tran and the instant application were under an obligation of assignment (or actually assigned) to Eagle Wireless International, Inc. Thus, in accordance with 35 U.S.C. § 103(c) above, Tran cannot be used in an obviousness rejection of the claims of the instant application. At least for this reason, claims 6 – 14 are patentable.

V. Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Conley Rose Deposit Account Number 03-2769 and enter any time extension(s) necessary to prevent this case from being abandoned.

Respectfully submitted,


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